

The previous rejection of claim 30 under 35 U.S.C. §112, second paragraph, was withdrawn.

In response to the applicants' previously submitted arguments, the March 21, 2001 Office Action stated:

Applicant's arguments filed January 3, 2001 have been fully considered but they are not persuasive. The essence of said arguments is that criticality has been shown for the present membranes in the way of faster grafting rates than would be predicted by known art. This is an interesting supposition, however, it is not compelling for at least the following reasons:

- the present claims are drawn to a product. It is not clear how the reaction rate of one of the starting materials, i.e. a process variable, impacts the patentability of the resultant product. In this regard it is well settled that the patentability of a product rests with the actual product formed as opposed to the method by which it is formed and that applicant has the burden of establishing an unobvious difference over the reference product. *In re Marosi*, 218 USPQ 289; *In re Thorpe*, 227 USPQ 964.

(Office Action at page 3). The Office Action also stated that the record was "conspicuously absent" of a meaningful head-to-head comparison of certain grafting rates, and that that the reactivity of aromatic compounds and the rate of

grafting are functions of ring substitution were well known.
(See Office Action at pages 3-4).

Applicants submit that the portion of the Office Action quoted above mischaracterize the nature of the applicants' previous arguments. Applicants have argued that the conventional, prior art knowledge of the reaction rate of substituted styrene monomers would have discouraged persons of ordinary skill in the technology involved here from making the modification to D'Agostino that is proposed in the Office Action. Applicants therefore submit that the present record lacks any suggestion or motivation to modify the prior art, including D'Agostino, and that the Office Action fails to set out a *prima facie* obviousness case.

Applicants' claimed graft polymeric membranes comprise a preformed polymeric base to which has been graft polymerized a substituted α,β,β -trifluorostyrene ("TFS") monomer and/or a substituted trifluorovinyl naphthalene monomer. D'Agostino only describes the preparation of graft polymeric membranes by radiation grafting of unsubstituted TFS monomer to a polymeric base film. D'Agostino does not disclose or suggest that substituted TFS could or should be graft polymerized onto a polymeric base film. Here, a *prima facie* obviousness rejection requires that there be some suggestion or motivation to modify

D'Agostino by employing substituted TFS rather than unsubstituted TFS to form a product.

The prior art (more specifically, a technical publication by Dilli and Garnett) teaches away from such a modification, as discussed more fully in the applicants' prior Response submitted on December 26, 2000. Dilli and Garnett teach that styrene monomers with electron-donating substituents had lower reactivities in graft polymerization reactions, relative to unsubstituted styrene. Persons of ordinary skill in the technology involved here would therefore expect that TFS monomers with electron-donating substituents would also have lower reactivities relative to unsubstituted TFS, and that such substituted TFS monomers would not be suited to employ in D'Agostino's process for preparing grafted membranes. The Office Action does not identify any suggestion or motivation to modify D'Agostino despite the contrary teachings set forth in Dilli and Garnett.

In summary, a *prima facie* case of obviousness has not been established on the present record because there is no motivation to modify D'Agostino to produce the applicants' claimed graft polymeric membranes. To the contrary, the prior art teaches away from the very modification upon which the Office Action relies.

Second Supplemental Information Disclosure Statement

On March 26, 2001, the applicants' attorneys submitted a Second Supplemental Information Disclosure Statement for Japanese Patent Publication No. 60-110685, which was supported by the required statement under 37 CFR § 1.97(e)(2) (namely, that no item of information contained in the Second Supplemental IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing this statement after making reasonable inquiry, no item of information contained in this Second Supplemental IDS was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the Second Supplemental IDS). Applicants hereby request consideration of the Second Supplemental IDS and the reference disclosed therein. To the extent that a specific request or petition or payment of a fee is necessary for the consideration of the Second Supplemental IDS, please consider this to be such a request or petition for consideration of the Second Supplemental IDS charge any such required fee payment to Deposit Account No. 13-0017.

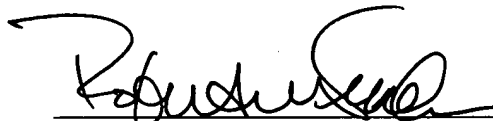
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In view of the foregoing remarks and submissions, applicants submit that claims 1, 2, 6, 18, 20, 22, 24, 29, and 30 are allowable. Applicants also submit that unelected claims 3-5, 7-

17, 19, 21, 23, 25-28 and 31-63, which were withdrawn from consideration in the September 25, 2000 Office Action, should be considered and allowed in view of the allowability of the elected claims. The Examiner is invited to telephone the applicants' undersigned attorney at (312) 775-8123 if any unresolved matters remain.

Please charge any fees incurred in connection with this submission to Deposit Account No. 13-0017.

Respectfully submitted,



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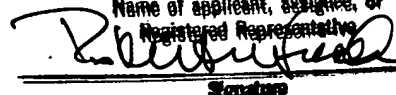
Dated: May 21, 2001

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